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Attorneys for Plaintiff and Counter-Defendant CENTOCOR ORTHO BIOTECH, INC. and Third-Party Defendants GLOBAL PHARMACEUTICAL SUPPLY GROUP, LLC, CENTOCOR BIOLOGICS, LLC and JOM PHARMACEUTICAL SERVICES, INC.

IN THE UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION

CENTOCOR ORTHO BIOTECH,  
INC.,

Plaintiff,

v.

GENENTECH, INC. and CITY OF  
HOPE,

Defendants.

AND RELATED COUNTER AND  
THIRD-PARTY ACTIONS.

Case No. CV 08-03573 MRP (JEMx)

**PLAINTIFF'S OPPOSITION TO  
DEFENDANTS' EX PARTE  
APPLICATION FOR A  
PROTECTIVE ORDER**

Date: TBA  
Time: TBA  
Place: Hon. Marianna R. Pfaelzer  
Courtroom 12

1 Plaintiff Centocor Ortho Biotech, Inc. (“Centocor”) hereby files its opposition  
2 to Defendants Genentech, Inc.’s and City of Hope’s (collectively, “Genentech”) ex  
3 parte application for a protective order to prohibit the deposition of third party Jeffrey  
4 Kushan. By filing its ex parte application for a protective order, Genentech seeks to  
5 improperly preclude Centocor from pursuing discovery intended to uncover facts  
6 relevant to Centocor’s defenses, including in support of Centocor’s well-pled  
7 inequitable conduct claims. As explained more fully below, Genentech positions are  
8 without merit and a protective order is not warranted.

9 **I. BACKGROUND**

10 Jeffrey P. Kushan is a partner in the D.C. office of Sidley Austin LLP and is  
11 the attorney who prosecuted the reexamination of the Cabilly II Patent which is the  
12 subject of this lawsuit.

13 On April 19, well before the April 30 fact discovery deadline, Centocor served  
14 on Genentech’s counsel a Notice of Deposition of Mr. Kushan (Exhs. A and B). On  
15 April 20, Genentech informed Centocor that it would accept service of a subpoena  
16 for Mr. Kushan, but complained that such a subpoena was allegedly untimely and  
17 that Genentech would not cooperate in producing Mr. Kushan for deposition  
18 (Exh. C). On April 21, Centocor served a subpoena for deposition of Mr. Kushan,  
19 issued out of the district court for the District of Columbia, since Mr. Kushan resides  
20 in Washington D.C., on counsel for Genentech who had agreed to accept service  
21 (Exh. D). After being unable to resolve the dispute between the parties relating to  
22 producing Mr. Kushan for deposition, on April 27, Centocor filed a petition to  
23 enforce the subpoena on Mr. Kushan in district court for the District of Columbia  
24 (Exh. E), and an ex parte application for leave to take the deposition of Mr. Kushan  
25 after the discovery cut off date in this court (D.I. 205). Genentech’s *ex parte*  
26 application for a protective order to prohibit the deposition of third party Jeffrey  
27 Kushan followed on April 28 (D.I. 207).  
28

Centocor initiated the above-captioned litigation by filing a declaratory judgment action seeking a ruling that Genentech's "Cabilly II" Patent is invalid or not enforceable (D.I. 1). In its initial complaint, Centocor included a claim that the Cabilly II patent was unenforceable due to inequitable conduct (*id.*). Centocor filed a first amended complaint and a second amended complaint, and in each of its complaints, it included allegations of inequitable conduct (D.I. 35 and 106). Genentech never challenged the sufficiency of any of those pleadings under Federal Rule of Civil Procedure 9(b), even though it had ample opportunity to do so. Now Genentech seeks to preclude Centocor from taking discovery in support of its inequitable conduct claims, arguing that Centocor has not met the heightened pleading standard for inequitable conduct. That argument is without merit.

## **II. ARGUMENT**

This is not a case where Centocor is trying to cure a deficiently pled inequitable conduct claim. Genentech has never alleged that the inequitable conduct claims in Centocor's complaint have not been explicitly pled. The cases that Genentech rely on in its *ex parte* application to support precluding discovery of inequitable conduct claims, *Resqnet.com, Inc. v. Lansa, Inc.*, No. 01 Civ. 3578 (RWS), 2004 WL 1627170 (S.D.N.Y. July 21, 2004) and *EMC Corp. v. Storage Tech. Corp.*, 921 F. Supp. 1261 (D. Del. 1996), are inapposite because in those cases, inequitable conduct was inadequately pled to begin with, and thus the defendants were precluded from taking discovery on a defense that was not clearly articulated.

Instead, here Genentech seems to argue that Centocor should be precluded from discovering facts that support Centocor's sufficiently pled inequitable conduct charges. But once a party articulates its claims or defenses in its complaint, the party must be entitled to conduct discovery to uncover facts those support that claims or defenses. If not, there would be little reason to conduct discovery at all. Thus, once Centocor alleged that Genentech had committed fraud in obtaining the Cabilly II

1 patent, Centocor is permitted to conduct discovery in an attempt to uncover facts that  
2 support its defense.

3 This is precisely what Centocor is attempting to do through the deposition of  
4 Mr. Kushan. Mr. Kushan served as outside counsel for Genentech during  
5 reexamination proceedings that challenged the validity of the Cabilly II patent. Mr.  
6 Kushan, along with Genentech's in-house patent agent Wendy Lee, conducted  
7 numerous in-person interviews during the course of the reexamination with the PTO  
8 examiners. For approximately three years, the PTO repeatedly rejected the claims of  
9 the Cabilly II patent. Then, in February 2009, three days after Mr. Kushan and Ms.  
10 Lee conducted their sixth in-person interview with the examiners, the PTO did an  
11 about face and issued a notice of intent to issue a reexamination certificate,  
12 confirming the patentability of the Cabilly II claims (Exh. F). There is insufficient  
13 information from the reexamination record to understand the reasoning for this  
14 change in position by the PTO. Centocor is entitled to discover what transpired  
15 between the Genentech representatives and the PTO at this February 2009 interview  
16 (as well as at all the other interviews). None of the communications between Mr.  
17 Kushan and Ms. Lee and the PTO are privileged, and Centocor has a right to inquire  
18 about what Mr. Kushan and Ms. Lee told the PTO about the Cabilly II patent claims  
19 and the prior art.<sup>1</sup>

20 Genentech complains that since Centocor's inequitable conduct allegations in  
21 its Second Amended Complaint do not explicitly name Mr. Kushan, then Centocor is  
22 somehow prohibited from taking his deposition. The fact that Mr. Kushan is not  
23 identified in Centocor's complaint does not prevent Centocor from discovering

24  
25 <sup>1</sup> After noticing Ms. Lee for deposition in January 2010, Genentech finally produced  
26 her for deposition on April 27. Ms. Lee could not recall any facts about any of the  
27 interviews conducted during the course of the reexamination beyond those that are  
28 reflected in the PTO-generated interview summaries. Thus, Mr. Kushan's deposition  
is particularly relevant here since he is only other Genentech representative that  
attended all of the interviews and the only witness from which the information may  
be obtained.

1 information from him. Nor is Centocor required to amend its pleadings every time it  
 2 discovers new facts that support a claim or defense that has been clearly articulated  
 3 in its complaint. If it were, that would lead to the absurd result that a party would be  
 4 compelled to amend its pleading perhaps hundreds of times during the course of  
 5 discovery as it discovered new facts.

### 6 **III. CONCLUSION**

7 For the foregoing reasons, it is requested that this Court deny Genentech's  
 8 application for a protective order and order Genentech to produce Mr. Kushan for  
 9 deposition on April 30, 2010.

10  
 11 DATED: April 29, 2010

Respectfully submitted,

12 AKIN GUMP STRAUSS HAUER & FELD LLP

13 By: /s/ Dianne B. Elderkin  
 14 Dianne B. Elderkin

15 and

16 CONNOLLY BOVE LODGE & HUTZ LLP

17 By: /s/ Bruce G. Chapman  
 18 Bruce G. Chapman

19 Attorneys for Plaintiff and Counter-Defendant  
 20 Centocor Ortho Biotech, Inc. and Third-Party  
 21 Defendants Global Pharmaceutical Supply  
 22 Group, LLC, Centocor Biologics, LLC and  
 23 JOM Pharmaceutical Services, Inc.  
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## CERTIFICATE OF SERVICE

I, Dori Dellisanti, the undersigned, certify and declare that I am over the age of 18 years, employed in the County of Los Angeles, State of California, and not a party to the above-entitled cause. My business address is Connolly Bove Lodge & Hutz LLP, 333 South Grand Avenue, Suite 2300, Los Angeles, California 90071.

On April 29, 2010, I served the foregoing documents described as:  
**PLAINTIFF'S OPPOSITION TO DEFENDANTS' EX PARTE APPLICATION FOR A PROTECTIVE ORDER** on the following person(s) in this action by placing a true copy thereof enclosed in sealed envelope addressed as follows:

David I Gindler Joseph M Lipner Irell and Manella 1800 Avenue of the Stars Suite 900 Los Angeles, CA 90067-4276	Attorneys for Defendant and Counterclaimant City of Hope Medical Center  Tel: 310-277-1010 Fax: 310-203-7199 Email: <a href="mailto:jlipner@irell.com">jlipner@irell.com</a> ; <a href="mailto:dgindler@irell.com">dgindler@irell.com</a> <a href="mailto:Coh.centocor.team@irell.com">Coh.centocor.team@irell.com</a>
Mark A. Pals Marcus E Sernel Matthew Shiels Kirkland and Ellis LLP 300 North LaSalle Street Chicago, IL 60654	Attorneys for Defendant and Counterclaimant Genentech, Inc. Tel: 312-861-2000 Fax: 312-861-2200 Email: <a href="mailto:mpals@kirkland.com">mpals@kirkland.com</a> <a href="mailto:msernel@kirkland.com">msernel@kirkland.com</a> <a href="mailto:mshiels@kirkland.com">mshiels@kirkland.com</a>
Daralyn J. Durie Ryan Kent Durie Tangri Lemley Roberts & Kent LLP 332 Pine Street, Suite 200 San Francisco, CA 94104	Attorneys for Defendant and Counterclaimant Genentech, Inc. Tel: 415-362-6666 Email: <a href="mailto:ddurie@durietangri.com">ddurie@durietangri.com</a> <a href="mailto:rkent@durietangri.com">rkent@durietangri.com</a>

☐ **BY MAIL** I am readily familiar with the firm's practice regarding collection and processing of correspondence for mailing. Under that practice it would be deposited with U.S. Postal Service on that same day with postage thereon fully prepaid at Los Angeles, California in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if the postal cancellation date or postage meter date is more than one day after date of deposit for mailing in affidavit.

☐ **BY PERSONAL SERVICE:** I caused such envelope to be delivered by hand to the addressee(s) as stated above.

☐ **FEDERAL EXPRESS:** I am readily familiar with the office practice of Connolly Bove Lodge & Hutz LLP for collecting and processing correspondence for overnight delivery by Federal Express. Such practice is that when correspondence for overnight delivery by Federal Express is deposited with the Connolly Bove Lodge & Hutz LLP personnel responsible for delivering correspondence to Federal Express, such correspondence is delivered to a Federal Express location or to an authorized courier or driver authorized by Federal Express to receive documents or deposited at a facility regularly maintained by

1 Federal Express for receipt of documents on the same day in the ordinary course  
2 of business.

3 [X] **BY E-MAIL:** (1) I caused copies of the above documents to be emailed to the  
4 interested parties based on the email addresses indicated herein, and/or (2) based  
5 on General Order 08-02, the attached document(s) was sent to the person(s) at  
6 the e-mail address(es) indicated above through the Court's Electronic Filing  
7 System (ECF).

8 [X] **FEDERAL** I declare that I am employed in the office of a member of the bar of  
9 this court at whose direction the service was made.

10 I hereby declare under penalty of perjury that the foregoing is true and correct.  
11 Executed on April 29, 2010 at Los Angeles, California.

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Dori Dellisanti

Name

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/s/ Dori Dellisanti

Signature